



AF #8
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TC 2702 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: James Nicholas Seymour

SERIAL NO.: 08/987,995

ART UNIT: 2745

FILED: 12/10/97

EXAMINER: Mehrpour,

TITLE: PORTABLE ELECTRONIC APPARATUS

ATTORNEY DOCKET NO.: 200-007711-US(PAR)

Assistant Commissioner for Patents

Box AF

Washington, D.C. 20231

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Sir:

This communication is intended to be responsive to the FINAL Office Action dated March 29, 2000.

Claims 12-19 are presently in the application and stand rejected, claims 1-11 having been previously canceled.

As earlier related, the invention relates to portable electronic apparatus, specifically, a portable radio telephone provided with a sensor for sensing whether or not the telephone is coupled in intimate proximity to a rest. The rest may be a desk top, a car instrument panel top or a special stand for the telephone. As the inventive feature, the telephone has an inhibitor which inhibits operation of, or locks the telephone against operation, when the sensor senses that the telephone is absent from the rest.



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Claims 12-19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number 5,760,690). The Examiner further commented:

"Regarding Claims 12, 19, Saji teaches a radio telephone 1 including a rechargeable power supply and having coupling (bl, b2, al, a2, 10), means for connecting to a charger unit 6 for charging the power supply, the radio telephone comprising (See figure 1): the charging apparatus is provided with setting means for detecting whether the telephone apparatus is set in the predetermined portion of the charging apparatus or not, connection condition detecting means for detecting whether the contact of the telephone apparatus are electrically connected or not (Column 3 lines 10-14).

Saji fails to teach means responsive to the sensor sensing the absence of the charging unit for automatically inhibiting operation of the radio telephone. However, French teaches a portable apparatus providing alarm system, which includes various sensors for monitoring whether the system is being moved from a stationary position (Column 2 lines 62-67). Therefore unauthorized movement of the system as a whole is prevented (Column 3 lines 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

Regarding Claim 13, Saji fails to teach a radio telephone wherein the sensor and locking means are operative for a power on mode of the portable electronic apparatus. However French teaches a portable apparatus wherein more sophisticated integration may also be accomplished by coupling disable circuit 28 to the computer's system to provide the ability to send commands and data to the CPU in order to place the CPU in a locked (inoperable) mode (Column 5 lines 37-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above

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teaching of French to Saji, in order to provide security for the cellular users.

Regarding Claim 14, Saji fails to teach a radio telephone wherein the inhibiting means is adapted to inhibit access to information stored in the portable electronic apparatus. However French teaches a portable apparatus which is useless to a would be-thief and less likely to be stolen. With such a system the data and information stored on a computer system employing such an alarm is protected from unauthorized access by a thief (Column 2 lines 17-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

Regarding Claims 15-16, Saji as modified by French discloses the inhibiting means. Therefore the user cannot make an outgoing call, and inhibits access to subscriber identity information stored in the memory.

Regarding Claim 17, Saji teaches a radio telephone wherein the sensor is adapted to sense charging voltage for charging the rechargeable power supply (See figure 1 numeral 32).

Regarding Claim 18, Saji fails to teach a system wherein operation of the radio telephone is restorable responsive to a security code input to the portable electronic apparatus. However French teaches a portable system which includes a disabling circuit. Upon unauthorized tampering, the system is disabled functionally until the proper keycode is entered via a keypad interface (Column 2 lines 10-14, Column 5 lines 15-18). Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching of French to Saji, in order to provide security for the cellular users."

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Respectfully, the Examiner's rejection of the claims as obvious in view of a combination of Saji and French seems to be entirely misplaced.

Saji relates to a cordless telephone set that signals an alarm if and when the respective recharging contacts between the phone and the charger are not properly coupled together. Saji does not allude to the problem of the phone being stolen; it is simply concerned with the problem of ensuring that the telephone battery is properly recharged. Thus, starting from Saji there would be no technical motivation at all to make any modifications to Saji's phone in the area of security.

If nevertheless, the skilled person wished to modify Saji's phone by adding a security feature, then assuming that he had French available to him (an unlikely assumption given that French is in the field of lap top computers) he would introduce French's motion sensor, because this is what French teaches him to do in order to combat theft of a laptop. As the Examiner has noted in the paragraph bridging pages 2 and 3 of his Office Action, the various sensors are for monitoring whether the system is being moved from a stationary position, that is, "motion sensing means for providing a motion signal" as recited in the patent. A hypothetical phone constructed through a combination of Saji and French would result in a phone with two distinct functions, both operating quite happily in their own independent ways: (1) Saji's charging alarm would still indicate when the electrical coupling was insufficient for charging (i.e. no-charge warning, and (2) French's motion sensors would sense when the phone is being moved.

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One can see that even through a combination of Saji and French, the present invention -- with its clever use of the functional relationship between the sensing means, coupling means and inhibiting means -- is not reached. Furthermore, the hypothetical Saji/French phone would be an inferior solution to the one presented in the present invention as it would require additional components, have higher power consumption, be heavier, and would be prone to more failures.

In the hypothetical phone, there is no functional relationship (except, as may be learned from applicant's disclosure) between the charging alarm feature and the security alarm feature. There is nothing in either reference that would prompt or lead a skilled person to combine the functionalities, i.e. no even vague indication that the charging circuitry could be tapped, or that it lends itself, as a sensing means for a security feature.

In sharp contrast, the present invention harnesses a synergistic link between charging, sensing and inhibiting: that is to say the inhibiting operation of the phone is in response to the sensing means of the recharge coupling means sensing a lack of contact with the charger.

This is the insight of the present invention, an insight which leads to clear advantages. Any allegation that the present invention is obvious over Saji/French is an allegation based singularly on hindsight.

Further, consider the pertinent holding of the court in In re Sernaker, 702 F.2d 989,

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994, 217 USPQ 1 (Fed. Cir. 1983). That court determined that obviousness in the context of PTO prosecution can usefully be synthesized in terms of two related inquiries: (1) "whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit;" and (2) "whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication." Thus, prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. In short, to "imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references or record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312 (Fed. Cir. 1983).

Applying the rationale and holdings of the Sernaker and Gore decisions to the situation at hand, it is respectfully solicited that the Examiner reconsider her



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determination that claims 12-19 are unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number S,760,690), finding those claims allowable, and thereby enabling a patent to issue by an early date.

Respectfully submitted,

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6/22/00

Date

CERTIFICATE OF MAILING

I hereby certify that this Request for Reconsideration in response to the FINAL Office Action dated March 29, 2000, is being deposited with the United States Postal Service today as first class mail addressed to Assistant Commissioner for Patents, Box AF, Washington, D.C. 20231.

6/22/00

Date

Ulisa M. Horner

Name of Person Making Deposit